

### REMARKS

The following is intended as a full and complete response to the Final Office Action mailed on June 9, 2004, which rejected and objected to the pending claims for the same reasons as set forth in the Office Action mailed on November 13, 2003. Claims 1-37 were examined. The Examiner rejected claims 1, 2, and 15 under 35 U.S.C. § 103(a) as unpatentable over Yoon (U.S. Pat. No. 6,292,291) in view of Cspikes (U.S. Pat. No. 5,778,132). The Examiner rejected claims 3-5, 10, 31, 35, and 36 under 35 U.S.C. § 103(a) as unpatentable over Yoon in view of Cspikes and in view of Bekcer ("Erbium-Doped Fiber Amplifiers Fundamentals and Technology.") The Examiner rejected claims 4, 6, and 7 under 35 U.S.C. § 103(a) as unpatentable over Yoon in view of Cspikes and further in view of Ohshima (U.S. Pat. App. Pub. No. 2001/0008459.) The Examiner rejected 8 and 9 under 35 U.S.C. § 103(a) as unpatentable over Yoon in view of Cspikes and further in view of Bekcer. The Examiner objected to claims 11-14, 16-18, and 32-34. Finally, the Examiner allowed claims 19-30 and 37.

### Rejections

In the Response to the Office Action mailed on November 13, 2003, Applicant stated:

"Yoon has a U.S. filing date of November 24, 1999 and claims priority under 35 U.S.C §119 only to Korean Application No. 98-50473, filed November 24, 1998. Yoon does not constitute prior art under 35 USC §102(e) because Applicant's filing date precedes Yoon's U.S. filing date of November 24, 1999, [which is] the critical date for §102(e) purposes. (See MPEP 706.02(f)(1)(II)(Example 3):

'For reference publications and patents of patent applications filed under 35 U.S.C. §111(a), the prior art dates under 35 U.S.C. §102(e) accorded to these references are the earliest effective U.S. filing dates. No benefit of the filing date of the foreign application is given under 35 U.S.C. §102(e) for prior art purposes (In re Hilmer, 149 USPQ 480 (CCPA 1966)). Thus, a publication and patent of a 35 U.S.C. §111(a) application, which claims benefit under 35 U.S.C. §119(a)-(d) to a prior foreign-filed application (or under 35 U.S.C. §365(a) to an international application), would be accorded its U.S. filing date as its prior art date under 35 U.S.C. §102(e).')

Thus, Yoon should be accorded a date under 35 U.S.C. §102(e) of November 24,

1999, not November 24, 1998. Further, Applicant believes that Yoon does not qualify as prior art under any other provision of 35 U.S.C. §102. All of the Examiner's rejections rely on Yoon as an integral part."

In the Final Office Action mailed on June 9, 2004, the Examiner responded to Applicant's argument on pages 3 and 10, respectively, stating:

"Regarding the Yoon reference, Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15."

"Applicant's arguments filed 3/19/2004 have been fully considered but they are not persuasive. Applicant argues that the Yoon reference is not applicable because the priority date of the instant invention antecedes the filing date of the Yoon reference. This is only true when accompanied by a certified English translation. Because a certified translation has not been submitted, the arguments are not considered to be persuasive."

Respectfully, Applicant believes the Examiner misunderstood Applicant's point. Applicant was not attempting to claim foreign priority. Rather, Applicant was/is arguing that the Examiner accorded the Yoon reference an incorrect critical date under §102(e). Instead of giving Yoon a critical date based on the date Yoon was filed in the U.S., the Examiner incorrectly gave Yoon a critical date based on the date Yoon was filed in Korea. Section 706.02(f)(1) of the MPEP makes clear that the Examiner may not rely on Yoon's foreign filing date (i.e., the filing date in Korea) when citing Yoon as prior art pursuant to 35 USC §102(e). Since the U.S. filing date of Applicant's application precedes the date that Yoon was filed in the U.S., Yoon cannot be used as prior art against this application. Therefore, Applicant submits that claims 1-37 are in condition for allowance, as the Examiner originally found, prior to the submission of Yoon in an IDS, dated June 5, 2003.

Applicant would like to thank Examiner Hughes for taking time to discuss this matter with Applicant's representative by telephone on August 3, 2004. Especially since Examiner Hughes did not issue the Final Office Action mailed on June 9, 2004 and recently received this case upon Examiner Stephen Cunningham's departure from the U.S. Patent and Trademark Office.

Conclusion

Based on the above remarks, Applicant believes that he has overcome all of the rejections set forth in the Final Office Action mailed June 9, 2004, and that the pending claims are in condition for allowance. If the Examiner has any questions, please contact the Applicant's undersigned representative at the number provided below.

Respectfully submitted,



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